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10/780,523	02/17/2004	Thomas V. Prendergast	2003P04401 US01	1349

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EXAMINER
SEREBOFF, NEAL

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 April 2008</u>.

2a)☒ This action is FINAL.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   In the amendment dated 4/28/2008, the following has occurred: Claims 1 - 5, 14 and 18

have been amended. Claims 1 - 20 are pending.

Notice to Applicant

2.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

3.   The Applicants are reminded of MPEP§ 2106(II)C(A) regarding statements of intended

use. Inclusion of prior art that also functions with the same intended use as described within the

claims does not impart patentability upon those claimed intended use functions. Quoting from

the MPEP:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this
subject matter that must be examined. As a general matter, the grammar and intended meaning of terms
used in a claim will dictate whether the language limits the claim scope. Language that <u>suggests or
makes optional</u> but does not require steps to be performed or does not limit a claim to a particular
structure does not limit the scope of a claim or claim limitation. The following are examples of language
that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

(B) "adapted to" or "adapted for" clauses,

(C) "wherein" clauses, or

(D) "whereby" clauses.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
requirements of this title.

5.   Claims 18 – 20 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and

recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such

as a particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v.

Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (18 - 20) are not tied to

another statutory class nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

7.   Claims 5 – 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Independent claim 5 includes the new limitation, "by filtering deficiencies concerning

entered current partial data from potential deficiencies related to unavailability of information

due to stage of processing." In particular, "due to stage of processing" is not found within the

originally filed detailed description. Within the Pre-Grant Publication, paragraphs 33 and 34,

error rule filtering is found. The paragraphs state, "If so, then this error is based on available

data fields and is a valid problem." And "If, on the other hand, any of the data fields related to

the error are not available for further processing, then this problem is a potential problem, but not

yet one that may be corrected." Therefore, the Examiner understands the filter based upon the

data available, regardless of the stage of processing. Claims 6 – 13 are rejected for the same

reasons as they are dependent upon claim 5.

Claim Rejections - 35 USC § 102

8.   ***Claim 1 - 20*** are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzgerald et al.,

U.S. Pre-Grant Publication Number 2003/ 0191665.

9.   As per claim 1, Fitzgerald teaches a system for processing partial claim data related to

provision of healthcare to a patient, comprising:

- An interface processor for receiving data representing a partial claim for reimbursement

  for services provided to a patient at different stages of patient interaction with a

  healthcare provider (paragraphs 19 - 21 and figure 2, #11 where the process can be run

  multiple times using the trial functionality),

  - Said partial claim comprising an incomplete claim lacking information needed for

    claim reimbursement by a payer organization (figure 6, #609 or paragraphs 39

    and 40 where data is missing or omitted);

- A pre-processor for processing said data representing said partial claim to identify

  deficiencies in said partial claim (paragraph 21), said processing including:

  - Applying rules to said data representing said partial claim to identify errors in said

    partial claim by filtering deficiencies concerning entered current partial data from

    potential deficiencies related to unavailability of information due to stage of

    processing (paragraphs 39 and 40), and

  - Determining a subset of said errors attributable to at least one of,

    (a) An invalid data item and

(b) An incomplete data item, in said partial claim representative data (paragraphs
39 and 40); and

- A result processor, for initiating generation of an alert message identifying said subset of
said errors to a user (paragraphs 39 - 41 where the error message is displayed).

10.   As per claim 2, Fitzgerald teaches the system of claim 1 as described above. Fitzgerald
further teaches the system wherein

- Said different stages include at least two of,

(a) Initial visit (paragraphs 17 and 20 where the beginning of the initial visit is not

defined by the specification and therefore could occur over the Internet),

(b) Admission and

(c) Consultation with a physician (paragraphs 17 and 20 where the consultation occurs

during various described encounters) and

- Said pre-processor determines said subset of said errors by at least one of,

(a) Determining a data item necessary for claim submission and determinable from said

partial claim representative data is missing (figure 6, #609 and paragraph 39) and

(b) A data item field contains an entry when it should be blank.

11.   As per claim 3, Fitzgerald teaches the system of claim 1 as described above. Fitzgerald
further teaches the system wherein

- Said preprocessor determines said subset of said errors using predetermined data

conditions and by determining data conditions that are not satisfied by at least one of,

(a) An individual data (paragraph 39) and

(b) Multiple data items, in said partial claim and

- Said rules are rules used to process data representing completed claims (paragraph 39 where rules reside in both categories or completed or not-completed).

12.   As per claim 4, Fitzgerald teaches the system of claim 1 as described above. Fitzgerald further teaches the system wherein

- Said pre-processor processes said data presenting said partial claim to identify deficiencies in said partial claim (paragraph 39) and

- Said result processor initiates generation of an alert message identifying errors to a user (figure 3, #315), at each stage of said different stages of patient interaction with a healthcare provider and permitting a user to correct deficiencies in said partial claim while the patient is present (paragraph 41 where the trial validation can be run at any point).

13.   As per claim 5, Fitzgerald, as understood, teaches a system for processing partial claim data related to provision of healthcare to a patient, comprising:

- A claim data collator for receiving and collating data related to a partial claim for a particular patient (paragraph 17),
  - o Said partial claim data being received from a data collection system at different stages of patient interaction with a healthcare provider (paragraphs 19 - 21 and figure 2, #11 where the process can be run multiple times using the trial functionality),
  - o Said partial claim comprising an incomplete claim lacking information needed for claim reimbursement by a payer organization (figure 6, #609 or paragraphs 39 and 40 where data is missing or omitted);

- A source of rules for use in processing collated claim data of a partial claim (paragraphs

  17 and 18);

- A pre-processor for submitting said collated claim data of said partial claim for

  processing using said rules to identify deficiencies in said collated claim data of said

  partial claim (paragraphs 21) by filtering deficiencies concerning entered current partial

  data from potential deficiencies related to unavailability of information due to stage of

  processing (paragraph 35 where it is a specific set of data for a specific data and

  paragraph 36 where the data and rules are collated and triggered during step 309); and

- A result processor,

  o For initiating generation of an alert message identifying said deficiencies to a user

    of said data collection system and enabling said user to potentially correct said

    deficiencies (paragraphs 39 and 40),

    ▪ Said pre-processor processes said data representing said partial claim to

      identify deficiencies in said partial claim (paragraphs 39 and 40 where

      information is missing) and

    ▪ Said result processor initiates generation of an alert message identifying

      errors to a user, at each stage of said different stages of patient interaction

      with a healthcare provider (paragraphs 39 - 41 where the error message is

      displayed. The Examiner notes that the claim allows for the message to be

      the same regardless of the problem or stage.) and

      • Permitting a user to correct deficiencies in said partial claim while

        the patient is present (the Examiner notes that this limitation is

considered the intended result of the processor and therefore does

not add patentable weight).

14.   As per claim 6, Fitzgerald teaches the system of claim 5 as described above. Fitzgerald

further teaches the system wherein said pre-processor determines whether said collated claim

data of said partial claim is in condition for processing to initiate generation of a payment in

response to completion of said partial claim (paragraph 38).

15.   As per claim 7, Fitzgerald teaches the system of claim 5 as described above. Fitzgerald

further teaches the system wherein said system automatically processes said partial claim data

and initiates generation of said alert message identifying said deficiencies to said user during

user collection of information from a patient using said data collection system enabling a user to

correct said deficiencies before a collection session terminates (paragraphs 38 – 41).

16.   As per claim 8, Fitzgerald teaches the system of claim 5 as described above. Fitzgerald

further teaches the system wherein said system automatically processes said partial claim data

and initiates generation of said alert message substantially in real-time (paragraphs 41 and 42

where the trial is executed).

17.   As per claim 9, Fitzgerald teaches the system of claim 5 as described above. Fitzgerald

further teaches the system wherein said pre-processor identifies at least one of,

        (a) Blank data items (paragraph 39 where the item is missing or blank) and

        (b) Valued data items, present in said partial claim.

18.   As per claim 10, Fitzgerald teaches the system of claim 5 as described above. Fitzgerald

further teaches the system wherein said pre-processor

- Determines a subset of said rules in said rules source relevant to said partial claim
  (paragraph 21) and

- Processes said collated claim data of said partial claim using said subset of rules to
  identify deficiencies in said collated claim data of said partial claim (paragraphs 22 - 24
  where exceptions are found).

19.   As per claim 11, Fitzgerald teaches the system of claim 10 as described above.
Fitzgerald further teaches the system wherein said pre-processor determines a subset of said rules
in said rules source relevant to said partial claim based on at least one of,

   (a) Identified valued data items present in said partial claim (paragraph 21) and

   (b) A map linking particular rules of said rules source with particular items of claim data.

20.   As per claim 12, Fitzgerald teaches the system of claim 11 as described above.
Fitzgerald further teaches the system further comprising a maintenance user interface, the
maintenance user interface permitting a user of the system to monitor and modify rules employed
by the claim preprocessor (paragraph 24, Rules acquisition unit using Rule Maker interface).

21.   As per claim 13, Fitzgerald teaches the system of claim 12 as described above.
Fitzgerald further teaches the system wherein the map is a dedicated database appropriate for use
during specified interactions with a provider of claim data (figure 1, #18 or paragraph 21).

22.   As per claim 14, Fitzgerald teaches a system for verifying partial claim data, comprising:

- A repository including a first map respectively associating partial claim data items with a
  set of verification rules (figure 1, #18 or paragraph 21);

- An interface processor for receiving sets of partial claim data different stages of patient
  interaction with a healthcare provider (paragraphs 19 - 21 and figure 2, #11 where the
  process can be run multiple times using the trial functionality),

  - Said partial claim comprising an incomplete claim lacking information needed for
    claim reimbursement by a payer organization (figure 6, #609 or paragraphs 39
    and 40 where data is missing or omitted); and

- A claims processor (Figure 2, number 42, 46, 48, 52)

  - Responsive to a received set of partial claim data and the first map (paragraph
    18),

  - For applying the associated verification rules to the received set of partial claim
    data (paragraph 21)

    - To identify deficiencies in said collated claim data of said partial claim
      (paragraph 24, exceptions)

  - By filtering deficiencies concerning entered current partial data from potential
    deficiencies related to unavailability of information due to stage of processing
    (paragraphs 39 and 40).

23.   As per claim 15, Fitzgerald teaches the system of claim 14 as described above.
Fitzgerald further teaches the system further comprising a second map for identifying data
present in the set of partial claim data that is available for the application of any verification rule
(paragraphs 21, 29, 33 and 34 where the relationship rules repository contains the rules).

24.   As per claim 16, Fitzgerald teaches the system of claim 15 as described above.
Fitzgerald further teaches the system wherein the second map identifies data present in the set of

partial claim data that is available for validating other data items (paragraphs 21, 29, 33 and 34

where the relationship rules repository is able to validate all available data items).

25.   As per claim 17, Fitzgerald teaches the system of claim 16 as described above.

Fitzgerald further teaches the system further comprising a rules list creator (paragraph 24, rules

acquisition unit), for creating a list of rules to be applied by the claims processor to the received

set of partial claim data (paragraph 24 rules acquisition unit including Rule Maker).

26.   As per claim 18, Fitzgerald teaches a method for enabling a provider of reimbursable

services to automatically identify invalid data present in partial claim data sets needed to

complete a claim for reimbursement submitted to a payer, comprising the steps of:

- Receiving partial claim data pertaining to provision of reimbursable services to an

    individual at different stages of patient interaction with a healthcare provider (paragraphs

    19 - 21 and figure 2, #11 where the process can be run multiple times using the trial

    functionality),

    - Said partial claim comprising an incomplete claim lacking information needed

        for claim reimbursement by a payer organization (figure 6, #609 or paragraphs 39

        and 40 where data is missing or omitted);

- Creating a map containing data that associates (paragraph 21, relationship rules

    repository):

    (a) Respective data items present within the received partial claim data (paragraph 16);

    and

    (b) A set of one or more payer specified reimbursement rules (paragraph 16); and

- Conditioning a claims processor to apply to the received partial claim data (Figure 2, number 42, 46, 48, 52),
    - The associated payer specified reimbursement rules as specified by the map (paragraph 18) and
    - To identify data not complying with the applied rules as invalid by identifying errors in said partial claim data by filtering deficiencies concerning entered current partial data (paragraph 24, exceptions) from potential deficiencies related to unavailability of information due to stage of processing (paragraphs 39 and 40).

27.   As per claim 19, Fitzgerald teaches the method of claim 18 as described above. Fitzgerald further teaches the method comprising the steps of:

- Creating a list of invalid data identified as a result of applying payer specified rules to the received partial claim data (figure 6, error list or paragraph 40);
- Forwarding the list to a user designated by a provider of the reimbursable service (paragraph 41 where the user reviews the errors as the list is displayed); and
- Prompting the user to correct an error causing the partial claim data to be identified as invalid without significant delay (paragraph 40 and 41).

28.   As per claim 20, Fitzgerald teaches the method of claim 19 as described above. Fitzgerald further teaches the method comprising the step of automatically transmitting to the payer valid data needed to complete the claim when sets of partial data have been inspected and no data remains identified as invalid (paragraphs 41 and 42).

Response to Arguments

29.   Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

30.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ertel, U.S. Patent Number 5,307,262

Ferguson et al., U.S. Pre-Grant Publication 2003/ 0140023

Ferguson et al., U.S. Pre-Grant Publication 2003/ 0149603

Kalies, U.S. Pre-Grant Publication 2005/ 0071193

Santalo et al., U.S. Pre-Grant Publication 2006/ 0041487

31.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./
Examiner, Art Unit 3626
7/14/2008

/Robert Morgan/
Primary Examiner, Art Unit 3626